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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590

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EXAMINER

DESANTO, MATTHEW F

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/944,190

Applicant(s)

WING ET AL

Examiner

Matthew F DeSanto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-13,22-40,42-45,48-51,54 and 59-77 is/are pending in the application.
- 4a) Of the above claim(s) 27-30,32-40,42-45,50 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-13,22-26,31,48,49,54 and 59-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,8. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group II in Paper No. 10 is acknowledged. The traversal is on the ground(s) that Groups V and VI should be searched as well as Group II because this would not impose any additional burden on the examiner. This is not found persuasive because searching and finding the apparatus does not necessarily mean the examiner will find the method, therefore the examiner would have to perform another search. The search could consist of classes and subclasses not original performed when searching for the apparatus, and since some of the subclasses consist of thousands of patents, it would be considered a burden of search. The classification given is just one area of search for the broadest claim of the invention; therefore depending on the subject matter of the depending claims would necessitate a search in other classes and subclasses therefore causing a burden of search to the examiner. Thus the reason for the restriction being proper.

The requirement is still deemed proper and is therefore made FINAL.

2. Applicant's election of Species P in Paper No. 10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Applicant's failed to elect a Species for the bearing surface. A telephone call was made to John Pietrangelo, where he selected Species A, with traverse, but since applicant did not distinctly and specifically point out the supposed errors in the

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restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

4. Claims 27-30, 32-40, and 42-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

5. Claims 50 and 51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement over the phone.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 9 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. As to claims 9 and 31, the functional statement set forth in a "whereby" clause does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Mason, 244 F.2d 733, 114 USPQ 127 (CCPA 1957).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 9-13, 31, 48, 49, 54, 59, 60, 61, 62, 63, 64, 65, 74-77 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunlap et al. (USPN 5941852).

Dunlap et al. disclosed a trocar assembly with a cannula (132) and an obturator (18) and a first (27) and second bearing surface (35). (Figure 8). Wherein the first and second bearing surface slidably engage each other when rotating the obturator relative to the cannula.

As to claims 11-13, wherein the first bearing comprises an incline, and/or a boss and/or a linear and curvilinear surface. (Figure 8).

As to claims 48 and 49, wherein the first bearing surface is moveable relative to the cannula and the second bearing surface is moveable relative to the obturator. (Figure 8, and entire reference).

As to claims 59-61, 63, 64, 75 and 76 wherein the head assembly has a bearing surface, a fluid port with a valve. Figures 1, 3, 4, and 8.

As to claims 54, 62, and 74 wherein the head assembly comprises a seal. Figure 12A.

As to claims 65, 77 wherein the cannula is non-metallic, column 16, lines 30-33.

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11. Claims 22-26, and 66-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (USPN 5807338).

Smith et al. discloses a trocar assembly with a cannula (112) and obturator (110),

As to claim 23, wherein the cannula is uniformly tapered from a second inside diameter, larger than the first inside diameter. (Figures 1, 14 and 18 and entire reference).

As to claim 24, wherein the first inside surface of the cannula is smooth and continuous. (Figures 1, 14 and 18 and entire reference).

As to claims 25, 26, wherein the obturator comprises a first tapered surface extending from the maximum diameter of the first end to the tip and a second tapered surface extending from the maximum diameter to the outside of the shaft. (Figure 2, 5, and 12 and entire reference).

As to claims 66-68, 70-71, and 73 wherein the head assembly has a bearing surface (Figure 2 and 16), a fluid port with a valve. (Figures 14 and 16 and entire reference).

As to claim 69 wherein the head assembly comprises a seal. Figure 14.

As to claim 72 wherein the cannula is non-metallic, column 5, lines 8-19.

12. Claims 9, 10, 11, 13, 48, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Flom et al. (5971960).

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Flom et al. discloses a trocar assembly comprising a cannula and an obturator, wherein there is a first and second bearing surface, which rotate relative each other.

(Figure 1, 3, 10, 11 and entire reference).

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 1-703-872-9302 for regular communications and 1-703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 1-703-308-0858.

Matthew DeSanto  
Art Unit 3763  
November 21, 2002

  
ANH TUAN T. NGUYEN  
PRIMARY EXAMINER  
11/21/02